

an n-1 quantity of subframes, each of said subframes being adapted to receive a single disk;

a magazine, nondetachably carried by said chassis, said magazine being adapted to receive an n quantity of said subframes;

a mainframe;

n-1 of said subframes being received in said magazine when one of said subframes is received in said mainframe;

a disk reader adapted to read one of said disks when said disk is in a disk-reading position;

said mainframe being adapted to receive a single one of said subframes, said mainframe being movably carried by said chassis for movement between a first position at least partly inside said disk storage and playback device and a second position whereat access is provided to a subframe received therein such that a disk may be inserted therein;

and disk conveying means for transporting a selected one of said subframes from said magazine to said main frame when said main frame is in said first position.

REMARKS

The above amendments replace claim 1 of the original patent with 14 new independent claims, each of the first 12 having 8 dependent claims. In the parent application, claims were rejected over new prior art and for various informalities in the declaration.

The present amendment cures the prior art rejections by introducing new claims that distinguish the prior art over which claims in the parent case were rejected. The new claims also depart from the claims of the '001 patent to the extent necessary to patentably distinguish new prior art obtained from a new search performed by the Applicant during

September of 1996. Thus, the new claims seek to narrow the scope of the claims of the original patent. The new claims also broaden the scope of the original claims as discussed in the declaration.

The claims of the parent application were rejected under 35 U.S. C. §251 as being based upon a defective reissue declaration. The Applicant submits that the declaration executed and filed in the case is sufficient to satisfy the threshold requirements of section 251 and requests the Examiner to postpone any requirement for a new reissue declaration – a much shorter one in keeping with the new rules - be postponed until final disposition of the claims, *vis a vis* prior art, is determined.

Rejections over Kawakami

In the parent reissue application, then-pending claims 1, 4, 8, 9, 27, 36, 43, and 44 were rejected under 35 U.S.C. §102 as anticipated by Kawakami, a new reference discovered by the Examiner. New independent claims 45, 54, 63, 72, 81, 90, 99, 108, 117, 126, 135, and 144 patentably distinguish Kawakami.

New independent claims 45, 54, 63, 72, 81, 90, 99, 108, 117, 126, 135, and 144 each contain at least one limitation that is not shown by Kawakami. Therefore, the claims of the present application are not subject to rejection under 35 U.S.C. §102 over Kawakami. Claims 45 and 54 each contain the following limitations not shown by Kawakami:

first disk conveying means for transporting a selected one of said disks from said magazine to a first position aligned with said disk-reading position along a first straight line path in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path ...
second disk conveying means for transporting a disk not stored in said

magazine in a second straight line path beginning at an access position to said first position said first position being substantially fixed relative to said disk-reading position

Referring to Kawakami Figs. 18(a) and 18(b), the disk-reading position is DC7. The only positions identifiable with the "first position" are DC6, DC7, and DC8, since these are the only positions in common along the path satisfying both the limitation "from said magazine to a first position" and the path satisfying the limitation "beginning at an access position ... to said first position". However, as discussed below, neither of these paths satisfies the limitations "straight line" as required by claim 10.

The path from the magazine, position DC1, is defined by DC1-DC2-DC3DC4-DC5-DC6 and so on. The path from the access position, DC11, is defined by DC11-DC6-DC8 and so on. The only positions of overlap are, as stated above, along the path DC6-DC8-DC7.

When the device of Kawakami removes disks from the storage to the position DC6, DC7, or DC8, it transports them along path DC1-D2-DC3-DC4-DC5-DC6 (Note that in Fig. 18(b), disk position DC1 is mislabeled as DC11). During this process, lever 104 pushes the disk from the position in the storage DC1, up toward rolling pulley 352 where it reaches position DC2. Then rolling pulley 352 rotates and pushes the disk toward loading member 425 to bring the disk to position DC4. The loading member 425 then lifts the disk to position DC5 so that loading member 425 forms a ramp with the bottom of guide groove 301. The disk then rolls of its own weight until it reaches position DC6 in the disk-pocket 500. This path is clearly not a straight line as recited in claim 10.

For the above reasons, claim 10 and 19 are not subject to rejection over Kawakami.

Claims 28 and 37 each contain the following recitation which is also not shown by Kawakami:

a disk conveyor with at least one drive element engageable with a selected one of said disks and movable in at least one range such as to transport said selected one of said disks from said magazine to a first position along a first straight line path and such as to transport said selected one of said disks in a second straight line path beginning at an access position to said first position

Again, referring to Kawakami Figs. 18(a) and 18(b), the only positions potentially identifiable with the "first position" are DC6, DC7 and DC8, since these are the only positions in common along the path satisfying both the limitation "from said magazine to a first position" and the path satisfying the limitation "beginning at an access position... to said first position". However, as discussed above, neither of these paths satisfies the limitations "straight line" as required by claims 28 and 37.

Claims 46 and 55 each contain the limitations:

second disk conveying means for transporting a disk not stored in said magazine in a second straight line path beginning at an access position at least partly outside said disk storage and playback device to said magazine within said disk storage and playback device

In Kawakami, to transport disk from the access position to the magazine, the disk is transported along path DC11-DC6-D8-DC9-DC10. As can be seen in Fig. 18(a), this

path is clearly not meet the "straight line" recitation of claims 46 and 55 since the disk is transported in radial and axial directions along this path.

Claims 64 and 73 each contain the following limitations not shown by Kawakami:

a disk conveyor with at least one drive element engageable with a selected one of said disks and movable in at least one range... such as to transport said selected one of said disks in a second straight line path beginning at an access position... to said magazine

Again, as explained above, in Kawakami, the only path, otherwise identifiable with the "second... path" limitation, is not a straight line and therefore does not meet the limitations of claims 64 and 73.

Claims 82 and 91 each contain the following recitation which is not shown by Kawakami:

first disk conveying means for transporting a selected one of said disks from said magazine to an access position along a first straight line path in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path

In Kawakami, the only path identifiable with the "first ... path" is DC1-DC2-DC3-DC4-DC5DC6-DC7-DC8-DC12. As can be seen in Figs. 18(a) and 18(b) and as described above, this path is neither a straight line nor in a plane as required by claims 82 and 91. Note that the disk pocket mechanism of Kawakami of necessity moves the

disk to position DC7 as it transfers the disk from position DC1, to position DC12 even though it is not necessarily mounted for playback, because it is driven axially by a cam mechanism (See discussion at col. 2 1, line 66 through col. 23, line 3 and col. 24, line 56 through col. 25, line 8 and associated drawings).

Claims 100 and 109 each contain the following limitations not shown by Kawakami:

a disk conveyor with at least one drive element engageable with a selected one of said disks and movable in at least one range such as to transport said selected one of said disks from said magazine to an access position along a first straight line path, in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path

As explained above, the only path in Kawakami identifiable with the "first... path" does not satisfy the straight line and "in a... plane" recitation of claims 100 and 109.

For the foregoing reasons, none of the independent claims added by this amendment is subject to rejection over Kawakami.

One new prior art reference JP '452, shows, in Fig. 8, a device which receives disks at an access position and transports them via a carrier to a playback position along an L-shaped path. The playback position and magazine are fixed relative to the chassis. Disks are removed from the magazine in a radial direction into the carrier and the carrier moved in an axial direction to the fixed player. Disks removed from the magazine near the player move a smaller distance axially than disks more remote from the player.

Claim 10 contains the following subcombination which is not shown by JP '452:

- A) first disk conveying means for transporting a selected one of said disks from said magazine to a first position aligned with said disk-reading position along a first straight line path in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path;
- B) second disk conveying means for transporting a disk not stored in said magazine in a second straight line path beginning at an access position at least partly outside said disk storage and playback device to said first position within said disk storage and playback device; and
- C) means for displacing at least one of said magazine and said transport plane to bring said selected one of said disks into said transport plane, said first position being substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane.

If the first disk conveying means is identified with the mechanism used to move the disk from the magazine out to the carrier, then the first position is the position within the carrier and aligned with the holding position of the "selected" disk. In that case, clause B cannot be satisfied because the disk is transported in a straight line only to position which cannot coincide with the first position identified with clause A. That is, the two first positions cannot be satisfied by the same position because one position cannot be connected by straight lines to both the access and magazine positions.

Moreover, clause C cannot be satisfied by JP '452 because the mechanism cannot satisfy "said first position being substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane" for any "first position" identified for purposes of clause B. That is, to satisfy clause B, the first position must be taken as a point along the straight line of transport out of the magazine for a given disk. In that case, the clause "said first position being substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane" cannot be satisfied. This is because, since the magazine is fixed, the transport plane must be movable to select different disks, That is, the straight line of transport out of the magazine changes with the selected disk transported out of the magazine. Therefore, the first position is not "substantially fixed relative to said... transport plane" as required by the claim.

Thus, at least the above two clauses of claim 10 are not satisfied by the JP '452 reference. Therefore, claim 10 is not anticipated by JP '452.

Claim 19 contains clauses A and B, quoted above. For the reasons given above, clauses A and B cannot be simultaneously satisfied by JP '452. Moreover, claim 19 contains the following recitation:

said selected one of said disks being disengageable, while at said first position, from said first disk conveying means to permit reading by said disk reader

Reference JP '452 discloses no position, identifiable with the first position, for which the disk is disengageable while in such position. Therefore, this clause is also not satisfied by JP '452. Therefore, claim 19 is also not anticipated by JP '452.

Claim 28 contains the following recitation:

A) a disk conveyor with at least one drive element engageable with a selected one of said disks and movable in at least one range such as to transport said selected one of said disks from said magazine to a first position aligned with said disk-reading position, along a first straight line path, in a transport plane parallel to a primary plane of said selected one of said disks, transported along said first straight line path, and such as to transport said selected one of said disks in a second straight line path beginning at an access position at least partly outside said disk storage and playback device to said first position within said disk storage and playback device; and

B) said first position being substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane.

For the reasons discussed above relative to claim 10, clause A cannot be satisfied by JP '452 because there is no position common to the first and second paths as defined in claim 28. In addition, clause B also cannot be satisfied by JP '452 as discussed above in connection with claim 10 vis a vis JP '452. For the above reasons, claim 28 is not anticipated by JP '452.

Claim 37 contains clause A quoted above and therefore is not anticipated by JP '452 for the reasons given. In addition, claim 37 recites:

said selected one of said disks being disengageable, while at said first position, from said at least one drive element to permit reading by said disk reader.

As discussed above with regard to claim 19, this recitation is also not satisfied by JP '452.

Claim 46 contains the following recitation:

- A) first disk conveying means for transporting a selected one of said disks from said magazine to a first position aligned with said disk-reading position along a first straight line path in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path;
- B) second disk conveying means for transporting a disk not stored in said magazine in a second straight line path beginning at an access position at least partly outside said disk storage and playback device to said magazine within said disk storage and playback device; and
- C) means for displacing at least one of said magazine and said transport plane to bring said selected one of said disks into said transport plane, said first position being substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane.

Clause C and clause A cannot both be satisfied by the Fig. 8 device described by JP '452. This is because the "first position [cannot be] substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane". Moreover, clause B cannot be satisfied because the path between the magazine and the access position in the JP '452 device is a U-shaped path,

which is neither in a plane nor a straight line path. Because claim 46 contains limitations not shown by JP '452, claim 46 is not anticipated by JP '452.

Claim 55 contains clauses A and B quoted above. As shown, clause B cannot be satisfied by the JP '452, Fig. 8 device. In addition, any first position consistent with clause A that is identifiable in the Fig. 8 device cannot satisfy the following recitation of claim 55:

said selected one of said disks being disengageable, while at said first position, from said first disk conveying means to permit reading by said disk reader

for the same reasons discussed above with respect to claim 10. Because claim 55 contains limitations not shown by JP '452, claim 55 is not anticipated by JP '452.

Claim 64 recites:

A) a disk conveyor with at least one drive element engageable with a selected one of said disks and movable in at least one range such as to transport said selected one of said disks from said magazine to a first position... in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path, and such as to transport said selected one of said disks in a second straight line path beginning at an access position at least partly outside said disk storage and playback device to said magazine ...

B) means for displacing at least one of said magazine and said transport plane to bring said selected one of said disks into said transport

plane, said first position being substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane.

Clause B and clause A cannot both be satisfied by the Fig. 8 device described by JP '452 because the "first position [cannot be] substantially fixed relative to said disk-reading position, irrespective of a displacement of said one of said magazine and said transport plane". Moreover, clause A also cannot be satisfied because the path between the magazine and the access position in the JP '452 device is a U-shaped path, which is neither in a plane nor a straight line path. Because claim 64 contains limitations not shown by JP '452, claim 64 is not anticipated by JP '452.

Claim 73 contains clause A quoted above. As shown, clause A cannot be satisfied by the JP '452, Fig. 8 device. In addition, any first position consistent with clause A that is identifiable in the Fig. 8 device cannot satisfy the following recitation of claim 73:

said selected one of said disks being disengageable, while at said first position, from said first disk conveying means to permit reading by said disk reader

for the same reasons discussed above with respect to claim 10. Because claim 73 contains limitations not shown by JP '452, claim 73 is not anticipated by JP '452.

Claims 82 and 91 both contain the recitation:

- A) first disk conveying means for transporting a selected one of said disks from said magazine to an access position along a first straight line path in a transport plane parallel to a primary plane of said selected one of said disks transported along said first straight line path ...
- B) means for displacing at least one of said magazine and said transport plane to bring said selected one of said disks into said transport plane ...

Clause A is not satisfied by the Fig. 8 device because the path between the magazine and the access position in the JP '452 device is a U-shaped path, which is neither in a plane nor a straight line path. Clause B cannot be satisfied because JP '452 describes no "means for displacing at least one of said magazine and said transport plane". Because claims 82 and 91 contain limitations not shown by JP '452, neither of claim 82 and 91 is anticipated by JP '452.

Claims 100 and 109 recite, in part:

- A) a disk conveyor with at least one drive element engageable with a selected one of said disks and movable in at least one range such as to transport said selected one of said disks from said magazine to an access position along a first straight line path, in a transport plane parallel to a primary plane of said selected one of said disks transported by said along said first straight line path ...
- B) means for displacing at least one of said magazine and said transport plane to bring said selected one of said disks into said transport plane ...

Clause A is not satisfied by the Fig. 8 device because the path between the magazine and the access position in the J.P. '452 device is a U-shaped path, which is neither in a plane nor a straight line path. Clause B cannot be satisfied because JP '452 describes no "means for displacing at least one of said

magazine and said transport plane". Because claims 82 and 91 contain limitations not shown by JP '452, neither of claim 82 and 91 is anticipated by JP '452.

Status of Application

A status letter is filed concurrently with this amendment. The status letter summarizes the recent events in the present case. In view of the following (the surrounding facts about which are detailed in the status letter), the Applicant requests that the next office action be made non-final to permit the Applicant an opportunity to make a full amendment to the claims if any are rejected after the Examiner's first examination of the claims.

- 1) The informality in the Preliminary Amendment file June 6, 1997 was a simple matter of numbering the new claims by starting with the wrong claim number. The Preliminary Amendment was not outside of any statutory time period for filing. The Preliminary Amendment was clearly a bone fide, otherwise careful and thorough attempt to respond to each of the issues outstanding in the final office action issued in the parent case of the FWC. In fairness, the Applicant, at least arguably should have been granted an opportunity to correct the informalities noted by the Examiner in the December 8,

1998 communication, in consonance with MPEP section 714.03.

- 2) The Applicant encountered substantial delays (3 months) in curing the defect in the preliminary amendment, not only because the Examiner was not able to obtain the file but also because the properly filed amendment (March 18, 1998) was never matched with the PTO file.
- 3) The December 12, 1997 Office Action was at best unclear as to whether the Preliminary Amendment was entered, which delayed the Applicant's ability to respond properly to the issue of non-responsiveness. Also, the office action did not address any arguments presented in the Preliminary Amendment against the bases of rejections applied in the parent case, which were applicable no matter which claims were considered still to be pending.

The Applicant proposes that the Preliminary Amendment responds to issues outstanding in the parent case. To treat the Preliminary Amendment differently from the treatment accorded to Amendments by section 714.03 creates a situation where a minor informality, one which could be quickly and readily corrected, makes a easy target of the Applicant's Response because the status of the claims is precisely the same as before the prior office action (the one to which the Preliminary Amendment responds). The Examiner can reject the claims on exactly the same basis as in the parent case. Such a treatment is in direct conflict with the intentions behind MPEP section 714.03 and ignores the *bona fides* of

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the Applicant's attempt to advance the prosecution of the case on the merits. The Applicant believes the equities are such that this request should be granted.

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